



18 MAR 2003

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In re Application of :
LOOSMORE, Sheena M. *et al* :
U.S. Application No.: 10/031,165 :
PCT No.: PCT/CA00/00870 :
Int. Filing Date: 26 July 2000 :
Priority Date: 27 July 1999 :
Attorney Docket No.: 1038-1217 MIS :
For: RECOMBINANT HIGH MOLECULAR :
WEIGHT MAJOR OUTER MEMBRANE :
PROTEIN OF MORAXELLA :

**DECISION ON
PETITION UNDER
37 CFR 1.47(a)**

This is a decision on applicants' "Petition under 37 C.F.R. 1.47(a)" filed on 04 October 2002.

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02 FC:1254

1440.00 CH

BACKGROUND

On 17 January 2002, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an unexecuted declaration.

On 05 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that the declaration was not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68. Applicants were given two months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 15 May 2002, applicants submitted various documents including a declaration signed by three of the four co-inventors.

On 16 August 2002, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration submitted was not in compliance with 37 CFR 1.497(a) and (b) because it was not properly executed. Applicants were given a time limit of one month of the date of this Notification or within the time remaining in the Notification of Missing Requirements, whichever is longer. No extension of this time limit pursuant to 37 CFR 1.136(a) was allowed.

On 04 October 2002, applicants filed the instant petition which was accompanied by, *inter alia*, a "Declaration Under 37 CFR 1.47(a)" ("Decl.") by Reza Yacoob, a copy of

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an employment agreement signed by Mr. Sasaki, a four-month extension request, and a declaration executed by three of the four listed inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

The 37 CFR 1.47(a) applicant states that a check of \$1,600.00 for the petition fee and four-month extension fee was submitted with the instant petition. The USPTO did not receive a check with the instant petition. Nevertheless, the petition fee of \$130.00 and the four-month extension fee of \$1,440.00 has been charged from Deposit Account No. 19-2253 as authorized. Therefore, item (1) of 37 CFR 1.47(a) is complete.

The 37 CFR 1.47(a) applicant has also submitted a declaration signed by three of the four listed co-inventors, Sheena M. Loosmore, Yan-Ping Yang and Michael H. Klein on behalf of the nonsigning co-inventor, Ken Sasaki. The nonsigning inventor's name, residence, post office address and citizenship are typed on this declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (4) of 37 CFR 1.47(a) is satisfied.

Concerning item (2) above, the 37 CFR 1.47(a) applicant submitted a declaration by Reza Yacoob of the Patents Department of Aventis Pasteur Limited explaining her efforts to obtain the signature of the nonsigning inventor, Mr. Sasaki. Ms. Yacoob claims to have personal knowledge of the facts in her declaration.

Ms. Yacoob states that "[o]n February 14, 2002, I arranged for a complete copy of the specification for this application including drawings to be mailed to Ken Sasaki at his last known address . . . along with a Declaration and Power of Attorney document, with a request that he execute and return the paper. The requested executed Declaration and Power of Attorney has not been returned." Decl. at ¶ 3.

Ms. Yacoob also asserts that "[t]he invention . . . was made during the period of time that Ken Sasaki was employed by Aventis Pasteur Limited." *Id.* at ¶ 4. The 37 CFR 1.47(a) applicant included a copy of a "Confidentiality Agreement" between the nonsigning co-inventor and Connaught Laboratories Limited [former name of Aventis] and signed by Mr. Sasaki with the instant petition.

After a careful review of the petition, it is not clear whether the 37 CFR 1.47(a) applicant is alleging that the nonsigning co-inventor, Mr. Sasaki, cannot be reached or

is refusing to sign by his conduct. Section 409.03(d) of the MPEP discusses the proof required for each and states, in part: .

INVENTOR CANNOT BE REACHED

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** The steps taken to locate the whereabouts of the nonsigning inventor should be included [in a] statement of facts. It is important that the statement contain facts as opposed to conclusions. (Emphasis added)

REFUSAL TO JOIN

A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. **If there is documentary evidence to support facts**

alleged in the petition or in any statement of facts, such evidence should be submitted. (Emphasis added).

In addition, Ms. Yacoob states in her declaration that "a complete copy of the specification for this application, including drawings" were mailed to the nonsigning co-inventor at his last known address which was listed as:

MDS Pharmaceuticals
6850 Goreway Drive
Mississauga, Ontario
Canada, L4V 1V7

Section 409.03(e) of the MPEP discusses the last known address of a nonsigning inventor and states, in part:

That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

The 37 CFR 1.47(a) applicant must explain why the address of a company was used to send the above-captioned application to the nonsigning co-inventor, Mr. Sasaki, instead of his residence which is listed on the Initial Information Data Sheet in this file.

Moreover, the 37 CFR 1.47(a) applicant must provide documentary evidence that Mr. Sasaki received a complete copy of the application, or that he cannot be located after a diligent effort was made to contact him. Copies of the letters sent to Mr. Sasaki and the mailing documents are required. *See above.*

There is also no indication that the 37 CFR 1.47(a) applicant has attempted to contact Mr. Sasaki directly via the telephone and verified his refusal to cooperate. An attempt to contact Mr. Sasaki should be made and the facts should be made of record.

For these reasons, item (2) is not yet satisfied and the last known address of Mr. Sasaki required by item (3) of 37 CFR 1.47(a) must be explained. Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

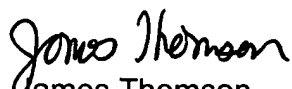
CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response

must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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